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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,735	10/21/2003	Zhimin Liu	13854-021002	7666
26181	7590	06/09/2004	EXAMINER	
FISH & RICHARDSON P.C. 3300 DAIN RAUSCHER PLAZA MINNEAPOLIS, MN 55402			NGUYEN, KHIEM M	
			ART UNIT	PAPER NUMBER
			2839	

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

zhc

Office Action Summary	Application No. 10/690,735	Applicant(s) ZHIMIN LIU	
	Examiner Khiem Nguyen	Art Unit 2839	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 and 11-16 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-16 is/are allowed.
- 6) ☒ Claim(s) 5-8, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 5-8, 11-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-10 of U.S. Patent No. 6,654,518. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are broad enough to read on the patented claims.

Claim Rejections - 35 USC § 112

3. Claims 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms "off-axis" and "on-axis" fibers recited in claim 11 seem unclear and lack proper antecedent basis.

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5-8, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu (6,400,508) and Lee (6,088,166) in view of Robinson (6,301,030).

Liu discloses a tap output collimator comprising a glass prism 7 having first and second incline surfaces (see figures 2a and 3a) for projecting a light beam into two angled projecting light beams. A birefringent crystal 8 for focusing the angled projecting beams into two output optical fibers disposed in a dual fiber capillary. Lee also discloses a prism 130 for projecting a light beam into two angled light beams and using Grin lens for focusing the projected beams. Liu seem lacking in the disclosure of placing a Grin lens in front of the dual/multiple fiber capillary 9. Lee, on the other hand, seem lacking in the provision of a dual/multiple fiber capillary for containing the output fibers 112, 113.

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Robinson shows the use Grin lens 30 for focusing the light beams to a pair of dual/multiple fibers disposed in a dual/multiple cappillary 28.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a Grin lens for focusing the angled light beams into the output fibers in the dual/multiple fiber cappillary of the collimator of Liu and to provide a cappillary for containing the dual/multiple fibers of Lee in view of Robinson's teachings. The use of a Grin lens is old and well known and would provide for better focus. The use of a dual/multiple fiber cappillary would provide better containment of the output fiber.

Allowable Subject Matter

4. Claims 13-16 are allowed.
5. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not disclose the tap output collimator as being recited in claims 1-16 of the instant invention. Specifically, the claimed features of a lens holder for holding a GRIN lens having a front portion extended beyond a front surface of said GRIN lens for holding a reflecting mirror at a distance away from said front surface of said GRIN lens; said reflective mirror is disposed at a small incline angle relative to a perpendicular line to said optical axis of said GRIN lens; and said GRIN lens further having a partially reflecting front surface for transmitting an output beam through and reflecting a portion of an input beam to said reflective mirror for reflecting said portion of


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said input beam into said GRIN lens with a tap out optical path separated from said incoming beam are not shown or suggested by the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khiem Nguyen whose telephone number is 571 272-2096. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached on 571 272-2800 ext 39. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Khiem Nguyen
Primary Examiner
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